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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,165	12/15/2003	Martin J. Dowling	I-2-0585.1US	4418

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EXAMINER

BALAOING, ARIEL A

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,165	Applicant(s) DOWLING, MARTIN J.	
	Examiner Ariel Balaoing	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 01/27/2006 have been fully considered but they are not persuasive.
2. In response to applicant's argument that BACH is nonanalogous art (see page 10 of the remarks), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, OSBORN and BACH are related to the handling of incoming messages from a wireless communication system and more specifically classification of incoming calls using a database (OSBORN col. 6, lines 36-48; BACH col. 2, lines 23-38 and col. 3, lines 15-26). BACH establishes priority ranking of incoming calls and routes the call according to priority.

Regarding claims 12-13, the applicant's argue "CAZIER does not teach or suggest a menu function control on a remote device in communication with a local wireless telephone" (see page 11 of the remarks); the examiner respectfully disagrees. CAZIER shows a peripheral device with menu functions associated with a remote device, while OSBORN discloses a cell phone in communication with a portable communication device. OSBORN inherently needs to provide a menu function in order to provide classification to the cell phone, while CAZIER is used in combination to show the use of the menu function on a peripheral device in control of a remote device. Also,

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it is well known in the art to provide control of devices from an external/remote device using a menu display as shown by CAZIER.

3. In response to applicant's argument that there is no suggestion to combine the references (see page 11 of the remarks), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a menu function of some form would inherently be used in the system disclosed by OSBORN to determine classification of telephone numbers. Also, it is well known in the art to provide control of devices from an external/remote device using a menu display as shown by CAZIER.

4. Applicant's arguments with respect to claims 1, 2, 4-9, 11-16, 19, and 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by MOONEY et al (US 2002/0098878 A1).

Regarding claim 14, MOONEY discloses a wireless transmit/receive unit **20** (WTRU) comprising: a communications transceiver to communicate with a wireless network **12, 14** in accordance with network protocols (abstract; Figure 1; paragraphs 9-13); a local radio link transceiver for communication with at least one remote communication unit (abstract; Figure 1; paragraphs 9-13); circuitry to transmit data through the local radio link transceiver concerning an alert other than a telephone call [fire alarm], and to communicate the alert to the at least one remote communication unit (paragraphs 9-13).

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 2, 4-9, 11, 15, 16, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of BACH et al (US 6,377,795 B1).

Regarding claim 1, OSBORN discloses a silent alerting system comprising: a wearable device (16-Figure 1; column 4:lines 31-45) comprising: a vibrator (column 6:lines 49-60); a receiver that activates the vibrator upon receiving a predetermined signal (abstract; column 5:lines 5-36; column 6:lines 49-60); a power supply that powers the vibrator and receiver (column 5:lines 5-36); and a communication device (10, 14-Figure 1) comprising: a transceiver **23** to link to a wireless network (column 4:lines 31-45); a classification device to classify incoming calls based on information from a database (column 6:lines 35-48); and a signaling device to silence said communication device, record a message, and send the predetermined signal according to the call

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classification to said receiver upon receipt of said call (column 6:line 35-column 7:line 43; as pointed out by the applicant on page 8 of the remarks, "Osborn teaches remotely annunciating a call to a portable communication device using data in a memory, such as an address book." In other words, calls are classified according to user indication of call numbers within a memory [database] of the device). However, OSBORN does not expressly teach classifying an incoming call based on a caller response to a query. BACH discloses classifying an incoming call based on a caller response to a query (column 2:line 54-column 3:line 26; also see page 10 of the remarks, "BACH discloses annunciating a call based on information from a database and a caller response to a query". BACH allows the call the ability to be classified as urgent, important or routine). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Regarding claim 2, OSBORN discloses a wireless transmit/receive unit (WTRU) comprising: a communications transceiver to communicate with a wireless network in accordance with network protocols (column 4:lines 15-45; as a cell phone in used in the specification, the device inherently includes a means for communicating with a wireless network in accordance with a network protocol); a local radio link transmitter, receivable by a remote signaling unit, for providing a user with an indication of an incoming call (column 7:lines 5-53); circuitry to classify an incoming call based on information from a database (column 6:lines 35-48; as pointed out by the applicant on page 8 of the

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remarks, "Osborn teaches remotely annunciating a call to a portable communication device using data in a memory, such as an address book." In other words, calls are classified according to user indication of call numbers within a memory [database] of the device); and circuitry to transmit data through the local radio link transmitter concerning calls in accordance with the call class (column 6:lines 35-48). However, OSBORN does not expressly teach classifying an incoming call based on a caller response to a query. BACH discloses classifying an incoming call based on a caller response to a query (column 2:line 54-column 3:line 26; also see page 10 of the remarks, "BACH discloses annunciating a call based on information from a database and a caller response to a query". BACH allows the call the ability to be classified as urgent, important or routine). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising the local radio link transmitter further providing caller identification data for display on the remote signaling unit (column 6:lines 19-35).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising the local radio link transmitter provided as part of a transceiver, thereby permitting the user

to communicate through the WTRU by use of the local radio link (column 5:line 5-column 6:line 4).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses wherein the WTRU using CLID data in said discrimination between classes of incoming calls (column 6:line 20-48). However, OSBORN does not disclose wherein the WTRU includes a circuit which uses a caller response in said discrimination between classes of incoming calls. BACH discloses wherein the WTRU includes a circuit which uses a caller response in said discrimination between classes of incoming calls (column 2:line 54-column 3:line 26). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising: the local radio transmitter provided a transceiver for providing communication with one or more remote communication units (column 5:line 36-column 6:line 4; column 7:lines 5-43); and circuitry to transmit data through the local radio link transceiver concerning calls, and to communicate with at least one of the remote communication units, thereby providing simultaneous communication between a wireless network connection and plural ones of the remote communication units (column 5:line 36-column 6:line 4; column 7:lines 5-43).

Regarding claim 8, OSBORN discloses a wearable device comprising: a receiver to receive and respond to transmissions from a local wireless phone when said phone is called, the response being according to a call class based on information from a database (column 5:line 36-column 6:line 4; column 7:lines 5-43; as pointed out by the applicant on page 8 of the remarks, "Osborn teaches remotely annunciating a call to a portable communication device using data in a memory, such as an address book." In other words, calls are classified according to user indication of call numbers within a memory [database] of the device); a vibrator that is actuated when said receiver receives said transmission (abstract; column 5:lines 5-36; column 6:lines 49-60); and a battery to power said receiver and said vibrator, whereby a user is alerted by said vibrator according to the call class when said phone is called (column 5:lines 5-36). However, OSBORN does not expressly teach classifying an incoming call based on a caller response to a query. BACH discloses classifying an incoming call based on a caller response to a query (column 2:line 54-column 3:line 26; also see page 10 of the remarks, "BACH discloses annunciating a call based on information from a database and a caller response to a query". BACH allows the call the ability to be classified as urgent, important or routine). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses additionally comprising

a means to attach said wearable device in such a way as to maintain it in contact with said user's body (16-Figure 1, 3, 4; column 4:lines 31-45).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35).

Regarding claim 15, OSBORN discloses a method for providing notifications to a user comprising: using a wireless electronic device classify a call based on information from a database (column 6:lines 35-48; column 7:lines 5-53); and wirelessly transmitting a local signal in response to the call, according to the call class (column 6:lines 35-48; column 7:lines 5-53). However, OSBORN does not expressly teach classifying an incoming call based on a caller response to a query. BACH discloses classifying an incoming call based on a caller response to a query (column 2:line 54-column 3:line 26; also see page 10 of the remarks, "BACH discloses annunciating a call based on information from a database and a caller response to a query". BACH allows the call the ability to be classified as urgent, important or routine). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Regarding claim 16, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses comprising providing a receiver capable of providing the user with a vibration signal according to the call class,

and able to receive said local signal, thereby providing the notification signal (abstract; column 6:lines 35-60).

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses wherein the database is on the wireless electronic device (col. 6, lines 36-48).

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of BACH et al (US 6,377,795 B1) and further in view of CAZIER (US 2004/0100505 A1).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon regarding the subject matter this claim is dependent upon. OSBORN further discloses further comprising: an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35); and a menu function control in communication with the local wireless phone; and a two-way voice communications capability with the local wireless phone, thereby permitting a user to communicate through the local wireless phone by use of the wearable device (column 5:line 5-column 6:line 4). However, the combination of OSBORN and BACH does not disclose a menu function control in communication with the local wireless phone. CAZIER discloses a menu function control in communication with the local wireless phone (paragraph 9, 24). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of OSBORN and BACH to provide a menu control on the remote device in communication

with the local phone, as taught by CAZIER, as this allows the user the ability to quickly change options of the remote device without the need of handling the local phone.

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon regarding the subject matter this claim is dependent upon. OSBORN further discloses comprising: an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35); and a two-way voice communications capability with the local wireless phone using a shared channel, thereby permitting one or more users to simultaneously communicate through the local wireless phone by use of the wearable device (column 5:line 5-column 6:line 4).

However, the combination of OSBORN and BACH does not disclose a menu function control in communication with the local wireless phone. CAZIER discloses a menu function control in communication with the local wireless phone (paragraph 9, 24).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of OSBORN and BACH to provide a menu control on the remote device in communication with the local phone, as taught by CAZIER, as this allows the user the ability to quickly change options of the remote device without the need of handling the local phone.

10. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of BACH et al (US 6,377,795 B1) as applied to claim 15 above, and further in view of BURGESS (US 2002/0128033 A1).

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of OSBORN and BACH

does not disclose wherein the database is on a radio network. BURGESS discloses wherein the database is on a radio network (paragraphs 23-25, 50, 65-68). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made modify the combination of OSBORN and HENRIKSSON to include the database on a radio network, as taught by BURGESS, as this allows the mobile device to reduce the memory needed for operation. Also, it has been well established in the art of caller identification to provide a database of callers from either a wireless electronic device (such as an address book) or within a radio network (HLR/VLR/MSC).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

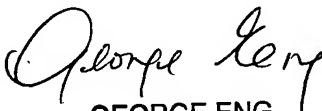
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing
Art Unit 2617 AB
4/12/2006

AB


GEORGE ENG
SUPERVISORY PATENT EXAMINER